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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/551,905	10/05/2005	Oliver Schadt	MERCK-3075	6249
23599 7590 06/25/2010 MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201				
EXAMINER JARRELL, NOBLE E				
ART UNIT		PAPER NUMBER		
1624				
NOTIFICATION DATE		DELIVERY MODE		
06/25/2010		ELECTRONIC		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

docketing@mwzb.com

### Office Action Summary

**Application No.**

10/551,905

**Applicant(s)**

SCHADT ET AL.

**Examiner**

NOBLE JARRELL

**Art Unit**

1624

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 March 2010.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1,3,4,7-9,14,15,17 and 19-25 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-9 and 19 is/are allowed.
- 6) ☒ Claim(s) 1,6 and 20-25 is/are rejected.
- 7) ☒ Claim(s) 3,4,14,15 and 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 1 March 2010 has been entered.
2. The rejections under 35 U.S.C. 112 1<sup>st</sup> and 2<sup>nd</sup> paragraph as well as 35 U.S.C. 102 and 103(a) have been overcome by the amendment filed 1 March 2010.

***Priority***

3. The priority date of the instant application is 5 April 2003.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
6. Claims 1, 6, 20, 21, 22, 23, 24, and 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Portnoy (*Journal of Heterocyclic Chemistry*, **1969**, 6(2), 223-8, STN record attached).

***Determining the scope and contents of the prior art***

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Portnoy describes the preparation of four compounds (citation), which are shown below.

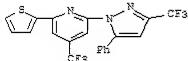
IT 22123-00-8P 22123-03-1P 22123-04-2P

22123-05-3P

RL: SYN (Synthetic preparation); PREP (Preparation)  
(preparation of)

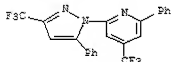
RN 22123-00-8 ZCAPLUS

CN Pyridine, 2-[5-phenyl-3-(trifluoromethyl)-1H-pyrazol-1-yl]-6-(2-thienyl)-4-(trifluoromethyl)- (CA INDEX NAME)



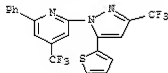
RN 22123-03-1 ZCAPLUS

CN Pyridine, 2-[5-phenyl-3-(trifluoromethyl)-1H-pyrazol-1-yl]-4-(trifluoromethyl)- (CA INDEX NAME)



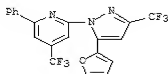
RN 22123-04-2 ZCAPLUS

CN Pyridine, 2-[5-(2-thienyl)-3-(trifluoromethyl)-1H-pyrazol-1-yl]-4-(trifluoromethyl)- (CA INDEX NAME)



RN 22123-05-3 ZCAPLUS

CN Pyridine, 2-[5-(2-furanyl)-3-(trifluoromethyl)-1H-pyrazol-1-yl]-6-phenyl-4-(trifluoromethyl)- (CA INDEX NAME)



In these compounds, a phenyl or thienyl ring is attached to the 6-position of a 4-trifluoromethyl-pyridine ring. The pyridine ring is attached to the 1-position of a 3-trifluoromethyl-pyrazole ring (through the 2-position of the pyridine ring) modified with a phenyl, thiophenyl, or furanyl ring at its 5-position.

***Ascertaining the differences between the prior art and the claims at issue***

In the instant claim set, variable R<sup>6</sup> is attached to the 5-position of a pyridine ring. In the Portnoy compounds, variable R<sup>6</sup> is attached to the 6-position of a pyridyl ring.

***Resolving the level of ordinary skill in the pertinent art***

Those of relative skill in the art are those with level of skill of the authors of the references cited to support the examiner's position. The relative skill of those in this art is MD's, PhD's, or those with advanced degrees and the requisite experience in preparation of compounds of the elected group.

***Considering objective evidence present in the application indicating obviousness or nonobviousness***

*In re Norris* (84 USPQ 458) teaches "Counsel for applicant in their brief acknowledge that the record herein does not establish new and useful compound defined by the rejected claim possesses one or more specifically identified properties to be recognized as unobvious or unexpected, as measured by every conceivable standard. Since the product claimed herein admittedly possesses no unexpected characteristics or properties, in view of what has hereinbefore been said, it is not patentable."

The difference between the Portnoy compounds and compounds of instant claim 1 is the point of attachment of variable R<sup>6</sup> to a pyridine ring where X is N. It is noted that these compounds are the final product of the synthesis. Thus, Portnoy expresses a reasonable expectation of success in the preparation of these compounds.

***Conclusion***

7. Claims 7-9 and 19 appear free of the prior art of record.

8. Claims 3, 4, 14, 15, and 17 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.
9. The following is a statement of reasons for the indication of allowable subject matter: Portnoy does describe compounds that anticipate or render obvious any of the recited limitations in the specified claims.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to NOBLE JARRELL whose telephone number is (571)272-9077. The examiner can normally be reached on M-F 8:30 A.M - 5:00 P.M. EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. James O. Wilson can be reached on (571) 272-0661. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Noble Jarrell/  
Examiner, Art Unit 1624